

Application No.: 10/027922

Docket No.: TGZ-003

REMARKS

Claims 1-43 were pending in the instant application. Amendment of claims 1, 4-8, and 12 is requested herein. Cancellation of claim 9 is also requested (its subject matter being incorporated into amended claim 1). Therefore, upon entry of the amendment presented herein, claims 1-8 and 10-43 will be pending.

The claims have been amended to recite more fully and distinctly the invention. No new matter has been added, and support for the amendments to the claims listed above may be found in at least the claims as filed. It is further noted that the amendments to the claims in the listing above address the "antecedent basis" rejections described in the outstanding office action.

Amendment of the claims herein should in no way be construed as an acquiescence to any of the rejections / objections set forth in the instant office action, or in any previous office action, and such amendments are requested solely for the purposes of expediting prosecution of the present patent application. Amendments to the claims are not presented for any reason related to patentability. Applicants reserve the option to prosecute the same or similar claims as those originally filed in the instant application or one or more or subsequent applications.

The outstanding office action rejects the claims, under section 112, or objects to the claims for lack of antecedent basis (e.g., claims 4-6, 12, and 7-8, 18-19, 28, 38, and 42-43). The claim amendments presented above are believed to address all of the objections and rejections relating to antecedent basis.

The office action also rejects the claims as obvious under section 103 over Dennis (U.S. Patent No. 5,501,957), Parce (U.S. Patent No. 5,942,443), and Ma (*Anal. Chem.*, 2000), alleging that Dennis discloses a study of certain substrates and an enzyme, that Parce teaches a microfluidic device, and Ma teaches a method of combinatorial synthesis.

In order to properly establish a *prima facie* showing of obviousness, Examiner must show the following three elements: (1) a suggestion or motivation to combine or modify the cited references; (2) a reasonable expectation of success; and (3) that the combination or modification of the prior art references teaches all the limitations of the claim at issue. Failure to show any one of the foregoing negates a *prima facie* showing. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. §2142 *et seq.*

Whether the rejection for obviousness depends on a combination of prior art references or a single reference alone, there must be some teaching, suggestion, or motivation to combine or modify the references. Usually, the suggestion comes from the teachings of the pertinent

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references, or from the ordinary knowledge of those skilled in the art that certain references are of special importance. Therefore, when examining the patentability of a claimed invention that combines known elements, “the question is whether there is something in the prior art as a whole to suggest the *desirability, and thus the obviousness*, of making the combination.” *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998) (emphasis added); *see also*, *GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984); and *In re Beattie*, 974 F.2d 1309, 1311-12 (Fed. Cir. 1992). In other words, it not sufficient that the prior art *could* be so modified. Rather, the prior art must teach or suggest that the prior art *should* be modified. *See In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Merely identifying all of the elements of a claim or their equivalents in the prior art is not sufficient to establish a *prima facie* showing of obviousness. Almost all inventions are combinations of old elements, and an examiner may often find every element of a claimed invention in the prior art. If this finding were sufficient “to negate patentability, very few patents would ever issue.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Therefore, in order to establish a *prima facie* rejection for obviousness, an “examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would [*i.e., not could,*] select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

In the instant office action, the mere fact that a combination of *three* references is proffered in an obviousness rejection implies the very unobviousness of the claimed invention. Furthermore, the office action makes provides no rationale for how one skilled in the art would, based on the teachings of the cited references, be compelled to arrive at the claimed invention, namely the claimed analytical method “within a microfluidic device.” The present invention provides such a method and thus advances the state of the art. It is not sufficient to show that certain claim elements may be found in the prior art; rather, in order to establish a *prima facie* obviousness rejection, the direction that one *should* modify the prior art in order to arrive at the claimed invention must be specifically suggested by the prior art itself. The Office action makes no such showing, other than a vague allegation that it is “apparent to one of ordinary skill in the art.”

Finally, the office action provides no rationale for why one skilled in the art would have combined the teachings of the three applied references with an *expectation of success*. As explained more fully above, merely identifying the an element of a claim in the prior art is not sufficient to establish a proper *prima facie* rejection, because nearly all inventions, which are almost totally combinations of old elements, would be obvious. In order to establish a *prima facie* rejection for

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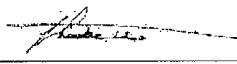
obviousness, an "examiner must show reasons that the skilled artisan . . . would [not could] select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet, supra*.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. TGZ-003 from which the undersigned is authorized to draw.

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Respectfully submitted,

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